

REMARKS

This is in response to the Office action mailed July 25, 2005.

Claims 3-27, 29, 38-47, 49, 50 and 52-54 are withdrawn from consideration, and claims 2 and 51 have been cancelled. Applicant has amended claims 1, 28, 30, 32, 33 and 48. Support for the amendments is found in the specification as originally filed at page 6, lines 6-8 and page 7, lines 4-9 and in the drawings. New claims 55-75 have been added. Support for new claims 55, 65 and 67 is found in the specification as originally filed at page 4, lines 15-19 and page 6, lines 6-8. Support for new claims 56 and 68 is found in the specification as originally filed at page 7, lines 4-9 and in the claims as originally filed at claim 30, page 15, lines 19-21. Support for new claims 57 and 69 is found in the specification as originally filed at page 4, lines 15-22 and in the claims as originally filed at claim 31, page 15, line 22 to page 16, line 2. Support for new claims 58, 59, 70 and 71 is found in the specification as originally filed at page 7, lines 10-17 and in the claims as originally filed at claims 32 and 33, page 16, lines 3-6. Support for new claims 60-63 and 72-75 is found in the specification as originally filed at page 8, lines 16-23 and in the claims as originally filed at claims 35-37, page 16, lines 11-19. No new matter has been added.

The drawings are objected to for failing to comply with 37 C.F.R. 1.84(p)(4) because character "42" has been used to designate both a pivot pin and a cylinder in Figure 1 and 37 C.F.R. 1.84(p)(5) because the drawings do not include the reference signs 11, 13, 86, 95 and 97, which are mentioned in the description. Applicant is submitting herewith a drawing page showing changes to Figure 1 wherein character "42" referencing a cylinder

DOCSBHM\1319579\1\

18

has been changed to character "44" and to Figures 3 and 6 wherein a character "84" referencing a tube has been change to character "86." Replacements sheets reflecting these amendments are also submitted herewith. In addition, applicant has amended the specification to remove all references to characters 11, 13, 95 and 97. Accordingly, withdrawal of the objection is respectfully requested.

The disclosure is objected to for including informalities. Applicant has amended the specification to address the informalities. Withdrawal of the objection is respectfully requested.

Claims 2, 28 and 51 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement and under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. The examiner states that it is not clear how relative linear movement between the boom and the arm is prevented, as it appears the expansion and contraction of the telescoping boom would classify as such. Applicant has cancelled claims 2 and 51 and amended claim 28 by removing all references to relative linear movement between the boom and the arm. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 1, 2, 28, 30-33, 48 and 51 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,032,956 to Mullet ("the '956 patent"). Applicant respectfully traverses the rejection on the ground that the '956 patent fails to disclose each and every element of the claimed invention as required under §102(b). Accordingly, withdrawal of the §102(b) rejection is respectfully requested.

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be *identically* shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added). These elements must be "arranged as in the claim" under review. *Lindemenn Maschinenfabrik v. American Hoist & Derrick Co.*, 221 USPQ2d 481, 485 (Fed. Cir. 1984). Therefore, one "must identify the elements of the claim, determine their meaning in light of the specification and identify corresponding elements disclosed in the allegedly anticipating reference." *Id.*

In the present case, each of the pending claims requires the presence of a backhoe boom and/or an arm connected with a means of transportation selected from a group consisting of a backhoe and a backhoe loader. Specifically, for example, claim 1, from which claims 55-64 depend, and claim 28, from which claims 30-37, 65 and 66 depend, require the presence of a backhoe boom, and claim 48, from which claims 68-75 depend, requires the presence of an arm connected with a means of transportation selected from a group consisting of a backhoe and a backhoe loader. The '956 patent fails to disclose a backhoe boom and an arm connected with a means of transportation selected from a group consisting of a backhoe and a backhoe loader.

More particularly, the '956 patent discloses a mobile weed and brush cutting machine including a mobile carrier and a turn-table rotatably mounted on a vertical axis on the carrier, a boom pivotally mounted on the turntable on an axis transverse to that of the turntable, a pair of hydraulic lifts extending between the turntable and the boom for raising or lowering the boom, a piston in the boom and a cutter head mounted on the end of the piston. The mobile carrier includes a rearwardly mounted prime mover, which is

DOCSBHM\1319579\1\

preferably a gasoline engine, connected by a drive means to the rear wheels. The prime mover includes an electric generator for the purpose of providing current for a motor which operates the cutter head. A steering wheel and an operator's seat are provided between the motor and a hydraulic means for supporting the cutter head.

No mention is made anywhere in the '956 patent of a backhoe boom or an arm connected with a means of transportation selected from a group consisting of a backhoe and a backhoe loader. Thus, it is respectfully submitted that the boom disclosed in the '956 patent is not a backhoe boom and the boom connected with the turntable supported by the carrier, as disclosed in the '956 patent, is not an arm connected with a means of transportation selected from a group consisting of a backhoe and a backhoe loader. Moreover, the carrier of the '956 patent is not a backhoe or a backhoe loader. Since the '956 patent fails to disclose each and every feature of the claimed invention, withdrawal of the §102(b) rejection is respectfully requested.

Claims 34-37 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '956 patent as applied to claims 28 and 30 above and further in view of U.S. Patent No. 4,269,241 to Hickman ("the 241 patent"). The '241 patent is relied upon to teach the claimed wheel and roller. However, the '241 patent fails to make up for the shortcoming of the '956 patent. In particular, the '241 patent fails to teach or suggest a back hoe boom or an arm connected with a means of transportation selected from a group consisting of a backhoe and a backhoe loader. Accordingly, withdrawal of the §103(a) rejection is respectfully requested.

Respectfully submitted,

SIROTE & PERMUTT, P.C.

By: 

C. Brandon Browning

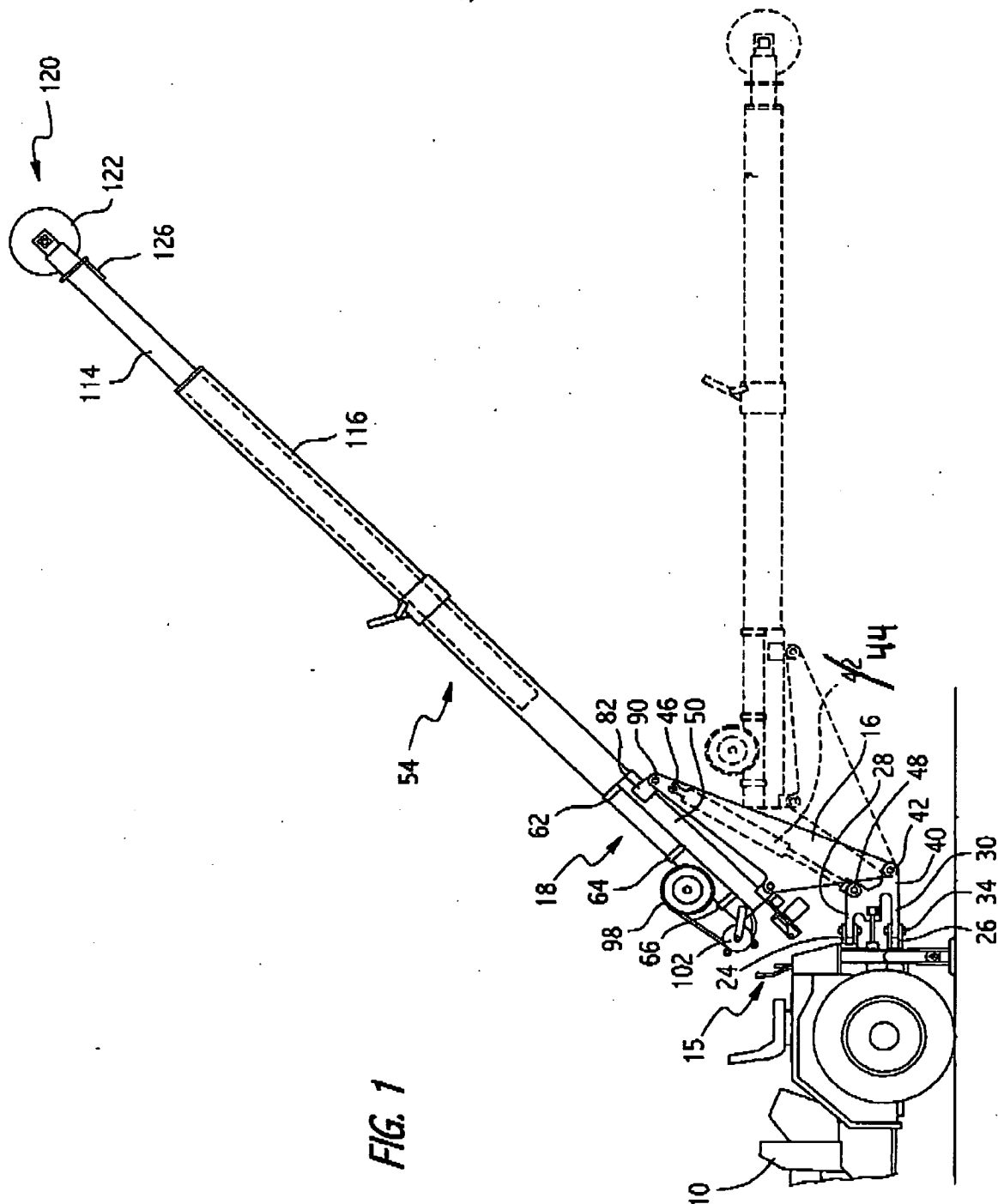
Reg. No. 44,570

205-930-5141

CBB:tr

Enclosures - Marked Up Version of the Drawings
Replacement Drawings

1/4



2/4

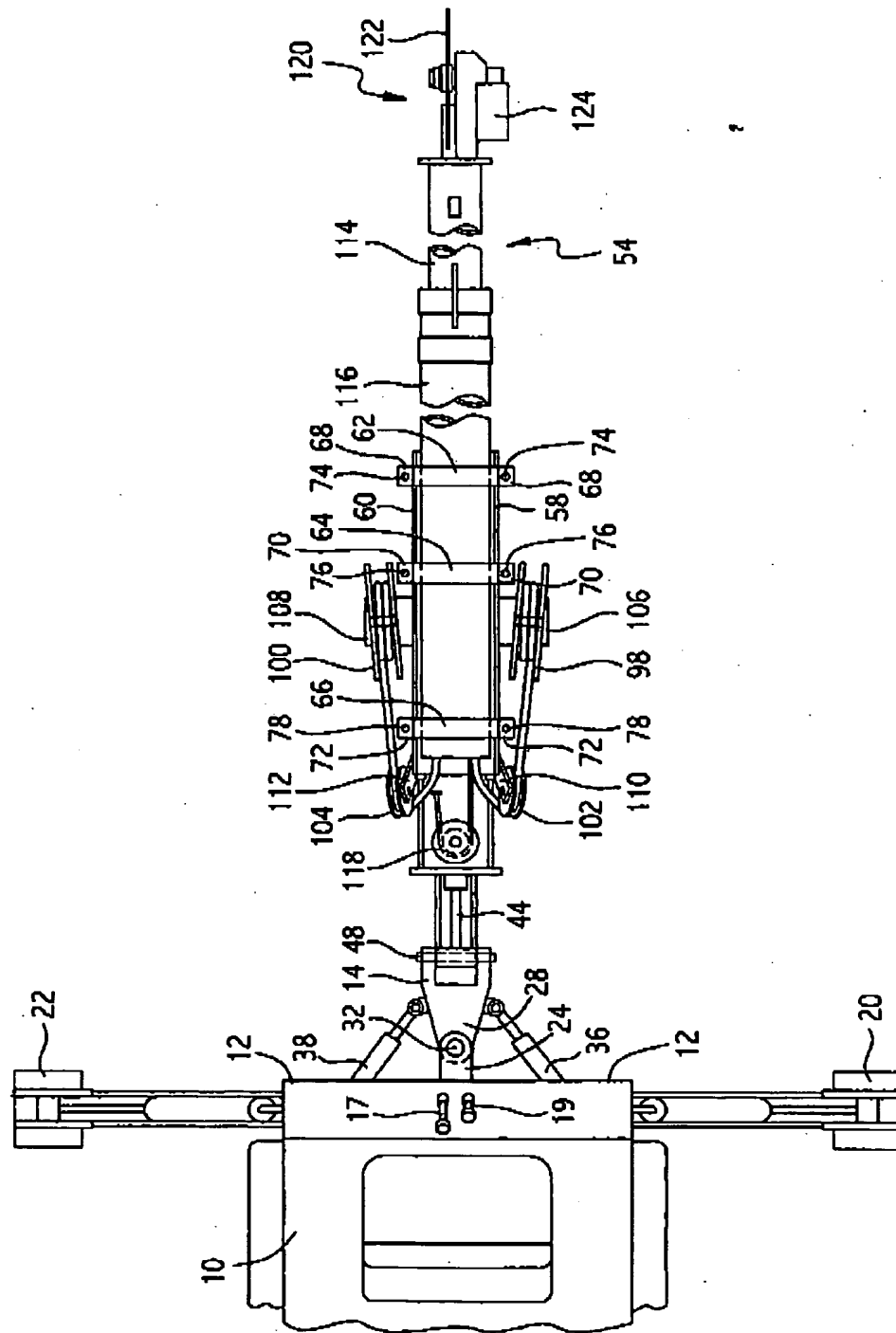


FIG. 2

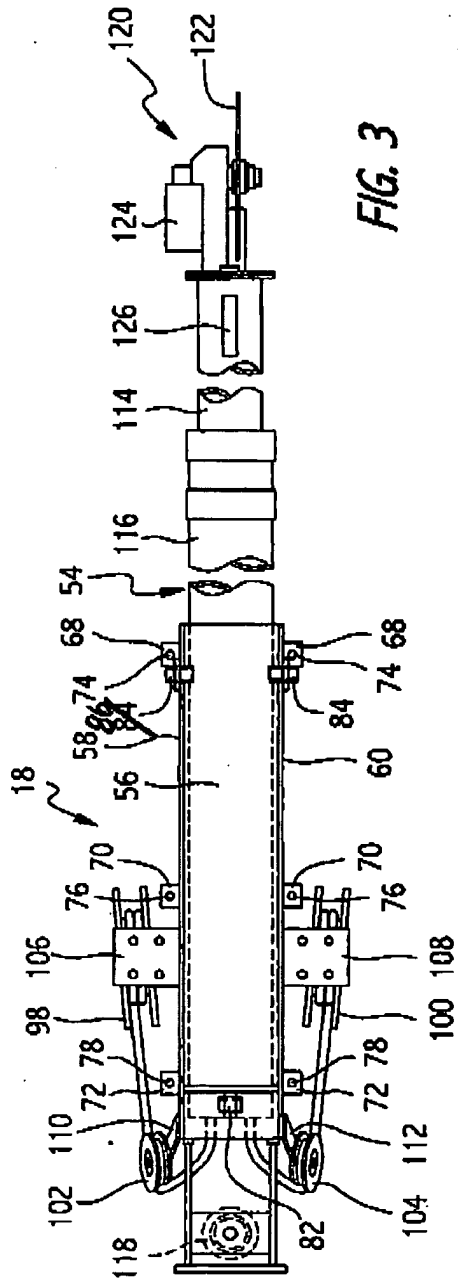


FIG. 3

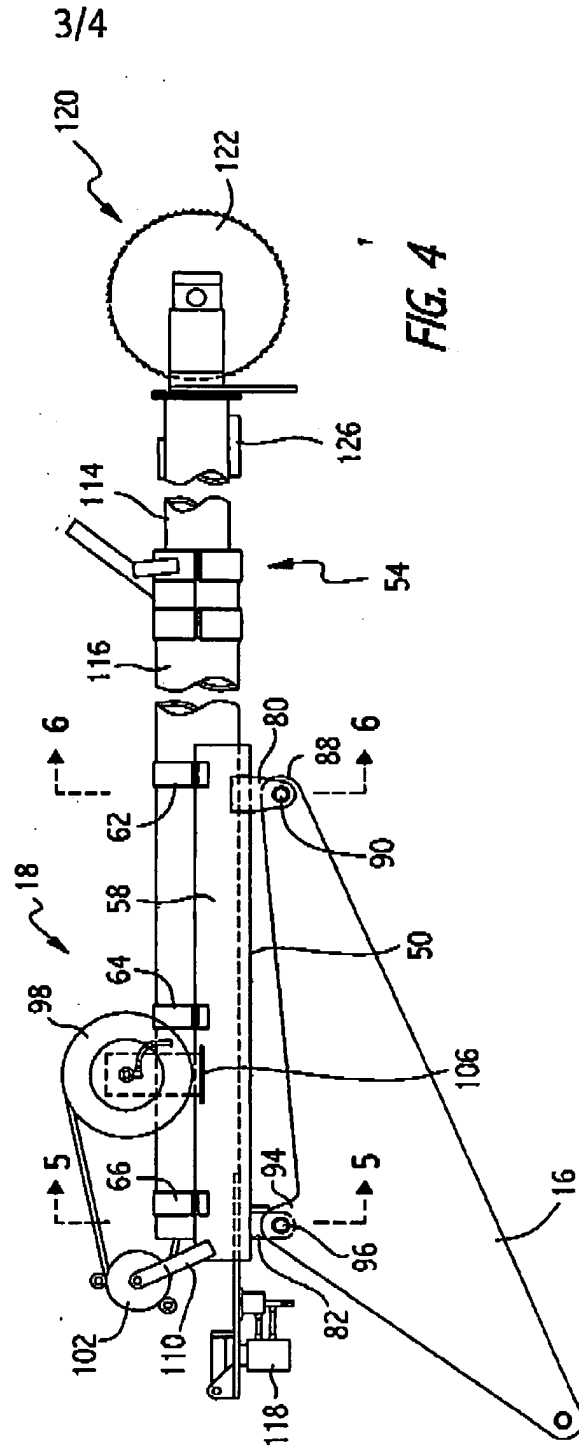


FIG. 4

4/4

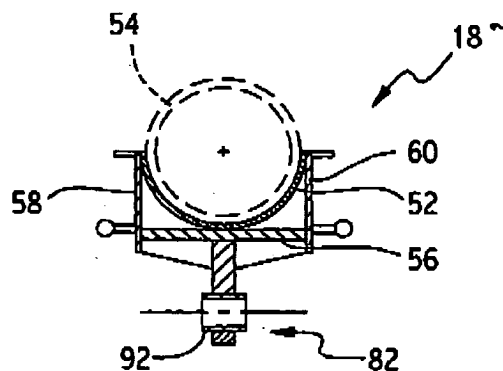


FIG. 5

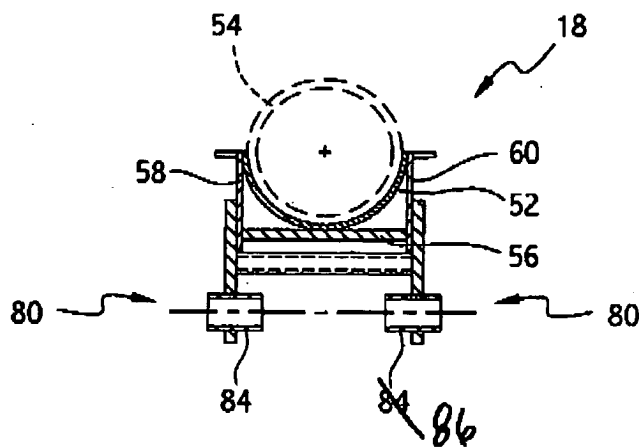


FIG. 6